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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,000	11/14/2003	Vanessa Chisholm	P1746R1P1	1570
9157	7590	08/24/2007	EXAMINER	
GENENTECH, INC.			GUZO, DAVID	
1 DNA WAY			ART UNIT	
SOUTH SAN FRANCISCO, CA 94080			PAPER NUMBER	
			1636	
			MAIL DATE	
			DELIVERY MODE	
			08/24/2007	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/714,000

Applicant(s)

CHISHOLM ET AL.

Examiner

David Guzo

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 59-61, 63-90, 93-99, 102, 104-111, 113, 115 and 116.
Claim(s) withdrawn from consideration: 91, 92, 100, 101, 112, 114.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: PTO-892.


DAVID GUZO
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants assert that "amplifiable selectable gene" and "selectable gene that is not amplifiable" have different meanings and refer to portions of the instant specification to support said assertion. This is not found persuasive because the portion of the specification referred to by applicants merely indicates that not all selectable markers are amplifiable without providing any reasoning or data to support this assertion. and without providing any indication of how a selectable marker which is not amplifiable differs structurally from a marker which is amplifiable.

With regard to whether the neomycin resistance gene is amplifiable, applicants assert that Thilly does not provide support for the statement in USP 5,919,635 that neomycin resistance marker is amplifiable and applicants cite Kaufman to indicate that neomycin resistance marker is not amplifiable. This argument is not found persuasive because Thilly is not cited in 5,919,635 as support for the fact that the neomycin resistance marker is or is not amplifiable, only that selectable markers are reviewed in Thilly. With regard to applicants' citation of Kaufman, Kaufman merely indicates that neomycin resistance gene has not been demonstrated to be amplifiable, not that it is not amplifiable. Indeed, the art is replete with references indicating that neomycin resistance gene is amplifiable (for example, see USP 6,677,134, columns 23, 29-30, etc. which teaches that plasmids comprising the neomycin resistance gene can be amplified wherein the resistance marker can be amplified to 20-50 copies per cell). Applicants also assert that the instant specification restricts amplifiable selectable genes to genes which are capable of being selected and amplified using a corresponding amplifying agent. This argument is not persuasive because the specification does not limit amplifiable selectable genes to those which are amplified using a corresponding amplifying agent. Finally, applicants' arguments that the examiner's definition of an "amplifiable selectable gene" (as determined from the instant specification) are not supported by the specification are not persuasive. The examiner was indicating that given the definition of "amplifiable selectable gene" in the instant specification (see p. 12), it would appear that any given selectable marker gene can be amplified.